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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,353	03/29/2001	Cedric G. DeLaCruz	2001-0159	3776

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EXAMINER

ZHONG, CHAD

ART UNIT PAPER NUMBER

2152

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,353

Applicant(s)

DELACRUZ, CEDRIC G.

Examiner

Chad Zhong

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-20 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL ACTION

1. This action is responsive to communications: Amendment A, filed 1/18/2004, this action has been made final.

Claims 1-20 are presented for examination.

Allowable Subject Matter

2. Claims 9-20 are allowed based on Applicant's persuasive arguments in the amendment.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach taking video of the electronic mail message recipient when the electronic mail message recipient has opened the electronic mail message.

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-6, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohn et al. (hereinafter Cohn), US 6,064,723.

5. As per claim 1, Cohn teaches a method for providing electronic mail message return receipts between at least one electronic mail message originator and at least one electronic mail message recipient, the method comprising:

receiving an electronic mail message which requires a video enhanced electronic mail message return receipt when received by the at least one electronic mail message recipient (Col. 32, lines 10-49);

providing the electronic mail message to the at least one electronic mail message recipient (Col. 32, lines 10-49); and

returning the video enhanced electronic mail message recipient to the electronic mail message originator, wherein the electronic mail message originator will be able to view the electronic mail message recipient reading the electronic mail message (Col. 32, lines 10-49).

6. As per claim 2, Cohn teaches the method of claim 1, further comprising:

capturing the at least one electronic mail message recipient on video which comprises providing a signal to a video capturing device to begin recording the electronic mail message recipient (Col. 32, lines 9-47).

7. As per claim 3, Cohn teaches the method of claim 1, wherein the video is saved in at least one format selected from the group of AVI, QUICKTIME, MPEG and REALVIDEO formats (Col. 32, lines 10-49).

8. As per claim 4, Cohn teaches the method of claim 1, wherein returning the video enhanced electronic mail message recipient to the electronic mail message originator comprises:

attaching a video file to the electronic mail message return receipt (Col. 32, lines 9-47).

9. As per claim 5, Cohn teaches the method of claim 4, wherein the video enhanced electronic mail message return receipt is an electronic mail message provided back to electronic mail message originator (Col. 32, lines 9-47).

10. As per claim 6, Cohn teaches the method of claim 1, further comprising:
determining when the at least one electronic mail message recipient starts reading the electronic mail message (Col. 14, lines 46-67; Col. 32, lines 9-47); and

determining when the at least one electronic mail message recipient stops reading the electronic mail message (Col. 14, lines 46-67; Col. 32, lines 9-47).

11. As per claim 8, Cohn teaches the method of claim 1, wherein the selected electronic mail message is tagged as requiring an electronic mail message return receipt by the electronic mail message originator (Col. 27, lines 19-27; Col. 32, lines 9-47).

Conclusion

12. Applicant's remarks filed 1/08/04 have been considered but are found not persuasive.

13. In the remark, the Applicant argued in substance that Cohn fails to disclose or suggest the novel concept of a method of providing electronic mail message return receipts, wherein the electronic mail message originator will be able to view the electronic mail message recipient reading the electronic mail message.

In response to Applicant's arguments, Cohn teaches the above section.

Referring to Col. 32, lines 9-48, wherein the image of the recipient is sent back to the originator for his/her viewing.

Applicant further argued in substance that Cohn does not teach or suggest any method of electronic mail message return receipts or recording video of the recipient each time he/she reads a new electronic mail

message.

In response to the return receipt, the returned video/image from the recipient is acting as a return receipt. Moreover, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., recording video of the recipient each time he/she reads a new electronic mail message) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

THIS ACTION IS MADE FINAL. Applicant is reined of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "Methods For Providing Video Enhanced Electronic Mail Return Receipts".

- i. US 6304897 Venkatraman et al.
- ii. US 2002/0087642 Wei et al.
- iii. US 6014689 Budge et al.


- iv. US 2002/0056123 Liwerant et al.
- v. US 2001/0004743 Krueger et al.
- vi. RFC 1889, 1996
- vii. "Screen Phone" Oct 13, 1999
- viii. "Virtual Voice's Back Door" Dec 1996

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (571)272-3946. The examiner can normally be reached on M-F 7:15 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BURGESS, GLENTON B can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CZ
April 5, 2005

 JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100